

2. Rejection of Claims 1, 3, 5-8, 10-13, 16, 23-27, and 33-39

The Examiner rejected claims 1, 3, 5-8, 10-13, 16, 23-27, and 33-39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,522,760 ("Azima II"). Applicants respectfully traverse this rejection for at least the following reasons.

The relevant portion of 35 U.S.C. § 102 provides (emphasis added):

A person shall be entitled to a patent unless - . . .

(e) the invention was described in . . .

(2) a patent granted on an application for patent by another filed in the United States *before the invention by the applicant for patent*[.]

In this case, Azima II's § 102(e) date is its actual U.S. filing date, *i.e.*, January 20, 1999. As hereafter described in detail, the subject matter claimed in the instant application is fully supported by its priority document, GB 9818719.8 (a copy of which is attached hereto), filed on August 28, 1998. As a result, as the subject matter claimed in the instant application predates Azima II's § 102(e) date, Azima II is not available as prior art under § 102(e).

Specifically, GB 9818719.8 contains the following passages, which clearly disclose that the vibration exciting system is adapted to apply torsion to the panel-form member, as recited in present claims 1, 3, 5-8, 10-13, 16, 23-27, and 33:

According to the invention, a vibration exciter for introducing bending waves into a resonant member, *e.g.*, an acoustic radiator panel, comprises means applying torsion to the member. The torsion applying means may be arranged to apply an alternating couple to a local region of the member.

GB 9818719.8 at p. 2, lines 10-15.

The torsion applying means may comprise a parallel pair of current carrying conductors fixed to the member and disposed parallel to the plane of the resonant member.

Id. at lines 16-18.

The torsion applying means may comprise an element rigidly coupled to and projecting away from the resonant member, and means to induce bending moments in the element.

Id. at p. 3, line 26 to p. 4, line 1.

As described in the response filed July 10, 2002, for a suspension to serve as a "pivot," it must have a high shear stiffness, *i.e.*, it must not be resilient. Corresponding to this understanding, GB 9818719.8 contains the following passages, which clearly disclose that

“the suspension acts as a pivot, thereby ... causing nodal lines corresponding to the resonance of the panel-form member to move towards an edge of the member,” as recited in claims 34-39:

An alternate embodiment of inertial torsional vibration exciter which reduces shear in the coil former is shown in Figure 1b, 1c, 1d and 2 where the coil is mounted on a cylindrical former tube. This reduces the effects of shear by winding the coil along a tubular former 10.”

Id. at p. 6, lines 20-25. Note that cited Figures 1b, 1c, 1d and 2 are substantially identical to Figures 18, 19, 21a/21b, and 20, respectively, of the instant application.

The magnet system may be mounted on a resilient suspension (not shown) such that the device operates as an inertial exciter due to the mass of the magnet system.”

Id. at p. 7, lines 10-14.

GB 9818719.8 thus clearly demonstrates that the subject matter recited in present claims 1, 3, 5-8, 10-13, 16, 23-27, and 33-39 was invented prior to the § 102(e) date of Azima II. As a result, Azima II is unavailable as prior under § 102(e). Therefore, the rejection of claims 1, 3, 5-8, 10-13, 16, 23-27, and 33-39 under § 102(e) is without foundation, and must be withdrawn.

3. Rejection of Claims 9, 14, 15, and 17-22

The Examiner rejected claims 9, 14, 15, and 17-22 under 35 U.S.C. § 103(a) as being obvious in view of Azima II. Applicants respectfully traverse this rejection for at least the following reasons.

First, as previously discussed, Azima II is unavailable as prior art under 35 U.S.C. § 102(e). Nor does Azima II qualify as prior art under any other section of § 102. As Azima II is unavailable as prior art under § 102, it cannot be used either alone or in combination with another reference to reject any claim under § 103(a). For this reason alone, the rejection of claims 9, 14, 15, and 17-22 must be withdrawn.

Second, even if Azima II were available under 35 U.S.C. § 102(e) as prior art, 35 U.S.C. § 103(c) precludes its applicability under 35 U.S.C. § 103(a), as the instant application and Azima II were commonly owned at the time this invention was made. Specifically, § 103(c) provides:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

At the time of the invention recited in the claims of the instant application, New Transducers Limited was the assignee of both Azima II and the current application. Accordingly, § 103(c) precludes the applicability of Azima II under § 103(a). Therefore, for either or both of these reasons, the rejection of claims 9, 14, 15, and 17-22 under § 103(a) should be withdrawn.

4. Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16 - 1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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